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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,030	07/25/2001	Amy E. Messner	10010532-1	7422
7590	12/27/2005		EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			BEKERMAN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	
			DATE MAILED: 12/27/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/916,030	MESSNER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Michael Bekerman	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-26 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 25 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**JEFFREY D. CARLSON**  
**PRIMARY EXAMINER**

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/25/2001</u> .	6) <input type="checkbox"/> Other: ____.

## DETAILED ACTION

### ***Information Disclosure Statement***

Any non-patent references listed on the IDS that don't have corresponding copies submitted have not been considered.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 322, 410, 420, 516, and 814. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

2. Claims 22-24 and 26 are objected to because of the following informalities: All of the aforementioned claims are apparatus claims, yet they all list a step of generating. Steps are used in method claims while apparatus claims should list components. Examiner considers each of the generating steps to read “means for generating”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**4. Claims 2, 5, 6, 11, 14, 15, 17, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 2, 5, 6, 11, 14, 15, and 17, the use of parentheses around “coupon” renders these claims indefinite because it is unclear whether the limitation(s) following the phrase “purchase money voucher” are part of the claimed invention. See MPEP § 2173.05(d).

Claim 5 recites the limitation “rendering to said consumer in response to said comparison step via said data network, a purchase money voucher (coupon) for items on both said first list and said second list”. The items on the first list are purchase

preferences. The scope of this claim is not clearly defined, and it is unclear as to how a coupon may be rendered for a purchase preference.

Claim 17 recites the limitation "said step of rendering" in Page 4, Line 28. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "said consumer list" in Page 7, Line 15. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1, 3, 4, 7, 9, 10, 12, 13, and 18-22 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.** All claims are analyzed to determine if they set forth a useful, concrete, and tangible result. The aforementioned claims set forth the generation of lists, but the mere generation of lists is not seen as accomplishing a useful result without the customer receiving the recommendations. If applicant intends for there to be a use for the generated lists (such as the providing of coupons based on the lists, as mentioned in the specification), that use should be claimed.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3622

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**8. Claims 1, 3, 4, 7, 9, 12, 16, and 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (U.S. Patent No. 6,313,745).** Suzuki shows systems and methods for managing consumer purchasing data that includes all the limitations recited in the above claims.

**Regarding claims 1, 3, and 4,** Suzuki teaches the obtaining, via a data network, of a list of consumer specified purchase preference items (items taken into the fitting room) (Abstract, Sentence 5), the comparing of those items to items in inventory (stock information database) (Column 6, Lines 62-67), the generating of a second list of items including at least one item that is at least: on said first list (different colors of an item still refer to the same item) (Column 8, Lines 1-3), conforming to at least one of said consumer-specified preferences (Abstract, Sentence 5), related to at least one item on said consumer list (Abstract, Sentence 5), and is a promoted inventory item on said list of preference items (Column 6, Lines 62-67), and the generating of a third list of items in inventory and available for purchase according to said preferences (the list generated by the server is the second list, while the list generated by the in-store terminal is the third list) (Abstract, Sentences 6 and 7). Suzuki also teaches the changing of consumer preferences items due to a consumer-specified extrinsic event (time of year, found based on consumer purchase and trial history) (Column 9, Lines 1-8).

**Regarding claims 7, 9, and 12,** Suzuki teaches the obtaining of a consumer purchasing profile (past trial and purchase history) and generating a list of recommended items in inventory based on the purchasing profile (Abstract, Sentence 8). When a consumer purchases an item, the number of items in inventory will inherently be adjusted.

**Regarding claim 16,** Suzuki teaches the obtaining of a first list of items purchased by a consumer, the obtaining of a second list of items purchased by a consumer (items purchased on different days may constitute different lists), the comparing of the lists to obtain a set of purchase preferences (Abstract, Sentence 8), and the rendering of a purchase incentive to the consumer based on the purchase preferences (Column 8, Lines 64-67).

**Regarding claims 18-21,** Suzuki teaches the generating of a computer file containing a list of required purchases and a set of purchase preferences (whether a purchase is important enough to be considered required is up to the individual consumer) (Abstract, Sentence 5), the transmitting of the file from a first computer to a second computer (sent from the fitting room to the server), and the receiving of a list of items to purchase compliant with the purchase preferences and determined by an extrinsic event (user-specified calendar date) (Abstract, Sentence 5 and Column 9, Lines 1-8).

**Regarding claim 22,** Suzuki teaches a data network interface for obtaining, via a data network, of a list of consumer specified purchase preference items (items taken into the fitting room) and a list of required purchases (whether a fitting room item is

Art Unit: 3622

important enough to be considered required is up to the individual consumer) (2 trips to the fitting room can be considered 2 different lists) (Abstract, Sentence 5), a means for comparing preference items to required items (Column 8, Lines 58-67), a means for generating a second list of items including at least one item that is at least: compliant to said consumer-specified preferences (Abstract, Sentence 5), and a means for generating a third list of items in inventory and available for purchase according to said preferences (the list generated by the server is the second list, while the list generated by the in-store terminal is the third list) (Abstract, Sentences 6 and 7).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2, 5, 6, 11, 14, 15, 17, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 6,313,745).**

Regarding claims 2 and 17, Suzuki doesn't specify the providing of a coupon for an item on the list. Suzuki does teach the recommending of items on sale. Official notice is taken that it is old and well known to offer a coupon for a sale item. Instead of running items on sale at the register, grocery stores will place coupon-dispensing machines in front of sale items. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give a coupon for a sale item

recommended by the system. Having a paper coupon in hand would greater compel a consumer to purchase the recommended item.

**Regarding claims 5, 6, and 11,** Suzuki teaches the obtaining, via a data network, of a list of consumer specified purchase preference items (items taken into the fitting room) (Abstract, Sentence 5) and a list of items previously purchased by the consumer (Abstract, Sentence 8), the comparing of preference items to history items (Column 8, Lines 58-67), and the generating of a list of items including at least one item that is at least based on the comparison (Column 8, Lines 58-67). Suzuki doesn't specify the providing of a coupon for an item on the list. Suzuki does teach the recommending of items on sale. Official notice is taken that it is old and well known to offer a coupon for a sale item. Instead of running items on sale at the register, grocery stores will place coupon-dispensing machines in front of sale items. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give a coupon for a sale item recommended by the system. Having a paper coupon in hand would greater compel a consumer to purchase the recommended item.

**Regarding claims 14 and 15,** Suzuki teaches the obtaining of a first list of items purchased by a consumer via a data network, the obtaining of a second list of items purchased by a consumer via a data network (items purchased on different days may constitute different lists), and the comparing of the lists to obtain a set of purchase preferences (Abstract, Sentence 8). Suzuki doesn't specify the providing of a coupon for an item on the list. Suzuki does teach the recommending of items on sale. Official notice is taken that it is old and well known to offer a coupon for a sale item. Instead of

running items on sale at the register, grocery stores will place coupon-dispensing machines in front of sale items. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give a coupon for a sale item recommended by the system. Having a paper coupon in hand would greater compel a consumer to purchase the recommended item.

**Regarding claim 23,** Suzuki teaches a data network interface for obtaining, via a data network, of a list of consumer specified purchase preference items (items taken into the fitting room) and a list of required purchases (whether a fitting room item is important enough to be considered required is up to the individual consumer) (2 trips to the fitting room can be considered 2 different lists) (Abstract, Sentence 5), a means for comparing preference items to required items (Column 8, Lines 58-67), a means for generating a second list of items including at least one item that is at least: compliant to said consumer-specified preferences (Abstract, Sentence 5), and a means for generating a third list of items in inventory and available for purchase according to said preferences (the list generated by the server is the second list, while the list generated by the in-store terminal is the third list) (Abstract, Sentences 6 and 7). Suzuki doesn't specify means for sending a purchase money voucher for an item on the list. Suzuki does teach the recommending of items on sale. Official notice is taken that it is old and well known to offer a coupon for a sale item. Instead of running items on sale at the register, grocery stores will place coupon-dispensing machines in front of sale items. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give a coupon for a sale item recommended by the system. Having a

paper coupon in hand would greater compel a consumer to purchase the recommended item.

**Regarding claims 24 and 25,** Suzuki teaches a user interface (the store clerk is a user) for obtaining, via a data network, of a list of consumer specified purchase preference items (items taken into the fitting room) and a list of required purchases (whether a fitting room item is important enough to be considered required is up to the individual consumer) (2 trips to the fitting room can be considered 2 different lists) (Abstract, Sentence 5), a means for comparing preference items to required items (Column 8, Lines 58-67), a means for generating a second list of items including at least one item that is at least: compliant to said consumer-specified preferences (Abstract, Sentence 5), and a means for transferring the second list containing items in inventory and available for purchase according to said preferences, and means for displaying said second list (Figure 10). Suzuki doesn't specify means for sending a purchase money voucher for an item on the list. Suzuki does teach the recommending of items on sale. Official notice is taken that it is old and well known to offer a coupon for a sale item. Instead of running items on sale at the register, grocery stores will place coupon-dispensing machines in front of sale items. It would have been obvious to one having ordinary skill in the art at the time the invention was made to give a coupon for a sale item recommended by the system. Having a paper coupon in hand would greater compel a consumer to purchase the recommended item.

**11. Claims 8, 10, 13, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent No. 6,313,745) in view of Richards (U.S. Pub No. 2001/0039519).**

Regarding claims 8, 10, 13, and 26, Suzuki doesn't specify the ordering of items in the recommendation list according to location within the store. Richards teaches a consumer recommendations system that orders recommended products according to location in the physical store (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to order the items on a list in any way, including the one taught by Richards. Richard's ordering method allows a user to find recommended products more quickly.

### ***Conclusion***

**12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

The following references are cited to further show the state of the art with respect to consumer recommendation systems:

U.S. Pub No. 2003/0105682 to Dicker

U.S. Pub No. 2002/0019763 to Linden

U.S. Pub No. 2003/0004831 to Owens

U.S. Patent No. 6,611,814 to Lee

U.S. Patent No. 5,832,457 to O'Brien

U.S. Patent No. 6,434,530 to Sloane

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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